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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,876

10/10/2006

Wolfgang Theimer

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EXAMINER

COBURN, CORBETT B

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

08/31/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,876	<b>Applicant(s)</b> THEIMER ET AL.	
	<b>Examiner</b> Corbett B. Coburn	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 5-16, 20-25 and 32-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 17-19 and 26-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/12/10, 3/18/10, 12/24/9, 4/6/6</u> .                        | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3714

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 1-4, 17-19 & 26-31 in the reply filed on 23 July 2010 is acknowledged. The traversal is on the ground(s) that Examiner failed to show a unique special technical feature. This is not found persuasive because the special technical feature was listed in each grouping of the claims. Applicant also stated that there was no appreciable burden. Examiner disagrees. As noted previously, the inventions are separate & distinct and searching these distinct inventions would entail an undue burden.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3714

4. Claims 17-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The latest guidance the Examiner has received is that claims reciting a “tangible computer readable medium” may be reasonably interpreted as reading on a signal. This renders the claim non-statutory. (*In re Nuijten*, 500 F.3d 1546, 1356-57 (Fed. Cir. 2007). The Office suggests that the claims be rewritten to recite a “non-transitory computer readable medium”. The Office further suggests that this will not normally be considered new matter – unless Applicant’s specification does not support a non-transitory embodiment because a signal *per se* is the only viable embodiment. (Note: Claim 19 cannot be rewritten to be patentable.)

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 31 recites the limitation "said other connected game devices" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 31 recites the limitation "said selection data" in lines 3-2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3714

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 17-19 & 26, 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by the Microsoft Disk Operating System (Henceforth MS-DOS).

**Claims 1, 17, 19:** MS-DOS had a command (DIR) for generating a game directory (i.e., listing of games) on an electronic gaming device. DIR queried an accessible memory (i.e., disk) for electronic games available for execution on said electronic gaming device, and generating a game directory having entries for each electronic game which is determined – it listed the programs found on the disk.

**Claim 2:** The DIR command listed the name of the directory (or file folder) that contained the programs. This is querying the accessible memory for context data (i.e., directory name) related to said electronic games, and including said context data into said game directory.

**Claims 3, 4:** A user could put the programs into any directory desired. MS-DOS was inherently capable of segregating multi-player games into their own directory where the directory name indicated a multiplayer ability of the game.

**Claim 18:** MS-DOS, like any other program, can be downloaded from a server.

**Claim 26:** The DIR command listed the entries from the game directory on a display of the electronic gaming device. The player could then type in a command to execute one of the games. This is receiving selection data related to the displayed entries and displaying the selection data on the display (since the text entered by the user was displayed on the monitor).

Art Unit: 3714

**Claim 28:** MS-DOS is a game directory generation and game selection application. In order to use it, it must be received & installed.

**Claim 29, 30:** A user who types in a command to execute a game sends a request to retrieve (from disk) and transfer (to internal memory) said game directory entries.

Clearly, the device receives the requests.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over MS-DOS as applied to claim 1 above, and further in view of Martin (US Patent Number 6,337,681).

**Claim 27:** MS-DOS teaches the invention substantially as claimed, but fails to teach that the display is a whiteboard. Martin teaches that it was known to use MS-DOS computers to control whiteboards. (Col 1, 45 & Col 11, 15) Whiteboards provide user interaction with applications programs. (Col 1, 18-19) It would have been obvious to one of ordinary skill in the art at the time of the invention to have used Martin's whiteboard with the MS-DOS operating system in order to allow user interaction with applications programs.

13. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over MS-DOS as applied to claim 1 above, and further in view of Hawkins et al. (US Patent Number 6,009,458).

Art Unit: 3714

**Claim 31:** It is difficult to understand what Claim 31 is claiming since it is so replete with antecedent basis errors. But Examiner believes Applicant is attempting to claim some sort of peer-to-peer networking scheme in which a player on one machine can start a game that is stored on another machine. Hawkins teaches such a peer-to-peer network. (Fig 2) It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the MS-DOS operating system to implement the peer-to-peer networking scheme of Hawkins (and thus allow a player to start a game that is stored on another machine) because any computer network must have an operating system.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett B. Coburn/  
Primary Examiner  
Art Unit 3714